

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Bruce Bokish

Examiner: Smith, Creighton H.

Serial No. 10/659,171

Art Unit: 2614

Filed: 09/09/2003

For: **EFFICIENT DELIVERY OF INFORMATION SERVICES INFORMATION**

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. Appellant also encloses a payment in the amount of \$1,520.00 to cover the fees associated with a Three-month Extension of Time and with this appeal brief as required by 37 C.F.R. § 1.17(c). If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

**APPEAL BRIEF**

**(1) REAL PARTY IN INTEREST**

The real party in interest is the assignee of record, i.e., Nortel Networks Limited of 2351 Boulevard Alfred-Nobel, St. Laurent, Quebec Canada H4S 2A9, which is wholly owned by Nortel Networks Corporation, a Canadian corporation.

**(2) RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences to the best of Appellant's knowledge.

**(3) STATUS OF CLAIMS**

Claims 1, 2, 4, 6, 8-19, 21, 23, and 25-34 were rejected with the rejection made final on March 27, 2006.

Claims 7 and 24 were objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form.

Claims 3, 5, 20, and 22 were cancelled.

Claims 1, 2, 4, 6-19, 21, and 23-34 are pending and are the subject of this appeal.

#### **(4) STATUS OF AMENDMENTS**

All amendments have been entered to the best of Appellant's knowledge.

#### **(5) SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention provides an information services system and method for providing information services, wherein a pointer is provided in response to a request for information from a user. The pointer provides an addressable location at which the requested information may be accessed by the user's telephony terminal, from which the information request was generated. The information may be accessed through a traditional browser or downloaded using a file transfer application. Since a pointer instead of the actual information is provided in response to the information request, limited-capacity messaging techniques can be used to transmit the pointer to the telephony terminal. Based on the capabilities of the applications running on the telephony terminal, the requested information may include any combination of text, graphics, audio, video, pictures, and the like, wherein the relative size of the requested information is only limited by the capabilities of those applications and the data access capabilities of the communication medium (Specification, paragraph 0005).

Claim 1 recites a method for facilitating delivery of requested information to a user comprising:

receiving a request for information from the user over a first network (see Figure 1, communication network 12, which may be a packet based (e.g., VoIP) network, a wireline network (e.g., PSTN), or a wireless network (e.g., a cellular network or a WLAN); Specification, paragraphs 0005 and 0013-0016; see also Figure 2, step 102);

sending to a telephony terminal (such as Figure 1, terminal 14) a pointer, which identifies a location where requested information responsive to the request is located via the first network (Specification, paragraphs 0005, 0015, and 0017; see also Figure 1, Figure 2 (step 114)); and

accessing the requested information in response to the request and storing the requested information at the location associated with the pointer (Specification, paragraphs 0005 and 0014-0017; Figure 2, steps 104-108),

wherein the pointer is used by the telephony terminal to access the requested information via the first network (Specification, paragraphs 0005, 0014, 0015, and 0018; see also Figure 1, Figure 2 (step 116)).

Claim 18 recites a system (such as information services system 116, Figure 3; Specification, paragraph 0019) for facilitating delivery of requested information to a user comprising:

at least one communication interface (such as communication interface(s) 28, Figure 3; Specification, paragraph 0019); and

a control system (such as control system 22, Figure 3; Specification, paragraph 0019) associated with the at least one communication interface and adapted to:

receive a request for information from the user over a first network (see Figure 1, communication network 12, which may be a packet based (e.g., VoIP) network, a wireline network (e.g., PSTN), or a wireless network (e.g., a cellular network or a WLAN); Specification, paragraphs 0005 and 0013-0016; see also Figure 2, step 102);

send to a telephony terminal (such as Figure 1, terminal 14) a pointer, which identifies a location where the requested information responsive to the request is located via the first network (Specification, paragraphs 0005, 0015, and 0017; see also Figure 1, Figure 2 (step 114)); and

access the requested information in response to the request and storing the requested information at the location associated with the pointer (Specification, paragraphs 0005 and 0014-0017; Figure 2, steps 104-108),

wherein the pointer is used by the telephony terminal to access the requested information via the first network (Specification, paragraphs 0005, 0014, 0015, and 0018; see also Figure 1, Figure 2 (step 116)).

## **(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

**A.** Whether claims 1, 2, 4, 6, 8, 14, 16-19, 21, 23, 25, 29, 31, 33, and 34 were properly rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0138347 A1 to Sakata (hereinafter “Sakata”).

**B.** Whether claims 1, 2, 4, 9-19, 21, and 25-34 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0190707 A1 to

Ljubicich (hereinafter “Ljubicich”) or U.S. Patent Application Publication No. 2004/0198329 A1 to Vasa (hereinafter “Vasa”) in view of Sakata.

## **(7) ARGUMENT**

### **A. Introduction**

For the rejections under 35 U.S.C. § 102(e), the Patent Office has not shown where all of the elements of independent claims 1 and 18 are shown with the requisite particularity to sustain an anticipation rejection. Claim 1 recites that a request for information, the sending of a pointer, and the accessing of information associated with the pointer are all done over the same network (“a first network” from claim 1). In other words, in the claimed invention, the request for information, the sending of a pointer, and the use of the pointer to access the requested information all takes place over the same single network (see Figures 1 and 2, and paragraphs 00014-0018 of the Specification). Specifically, there are two key differences between the presently claimed invention and Sakata. First, different networks are used to obtain and use the pointer in Sakata, whereas the same network is used in the claimed invention. Second, the claimed invention requires a request for information. In response to the required request for information, a pointer is returned, such that the location can be ultimately accessed via the same network. In contrast, Sakata discloses requesting a pointer, rather than information. Given the strict standards for anticipation, Sakata fails to anticipate independent claims 1 and 18 and the corresponding dependent claims.

For the rejections under 35 U.S.C. § 103(a), neither Ljubicich nor Vasa cure the deficiencies of Sakata, and as such, *prima facie* obviousness is not provided because each and every claim element cannot be found in either combination of references. Even if these claim elements were present, there is no motivation to combine the references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references, which it has not done in this case. Instead, the Patent Office is improperly combining the references using hindsight to reconstruct the claimed invention using Appellant’s disclosure as a template. In particular, the Patent Office has not provided any evidence to prove the motivation to combine the references, and has ignored the fact that Ljubicich is directed to an entirely different field of endeavor.

## **B. Summary of the References**

### **1. U.S. Patent Application Publication No. 2002/0138347 A1 to Sakata**

Sakata is directed to an information collection system that allows a user to access a network easily to obtain information. The information system includes a pointer sending means for sending a pointer to information to be acquired from a network based on a request. A portable terminal acquires information from an information provision means by using the pointer obtained after making a request of the pointer sending means. The user can then access the network by using the pointer sending means as an entrance (Sakata, Abstract).

Sakata provides a mobile terminal, which will request a pointer from a billboard via a Radio Frequency Identification (RFID) interface and receive the pointer via the RFID interface (see Sakata, Figure 1, and paragraphs 0035-0036). Notably, the request sent by the mobile terminal in Sakata is a specific request for the pointer, and not the actual information which is associated with the pointer (Sakata, paragraphs 0036-0037). Once the mobile terminal in Sakata retrieves the pointer from the billboard via the RFID interface, the pointer is used to access the information associated with the pointer through a different interface, such as an Internet interface (Sakata, Figures 1, 2, 4 and 5, paragraphs 0035-0037, 0042, 0045 and 0050). In effect, different communication networks are used to obtain and ultimately use the pointer.

### **2. U.S. Patent Application Publication No. 2004/0190707 A1 to Ljubicich**

Ljubicich relates to a system for providing information assistance including providing information for accessing a researched party without disclosing certain information about the researched party (Ljubicich, paragraph 0001). This may be accomplished by providing a user to an information assistance provider with a system access telephone number rather than the requested party's actual telephone number, in response to a request for directory assistance. With the access telephone number, the information assistance provider can connect the user to the requested party without disclosing the party's actual telephone number (Ljubicich, paragraph 0006).

### **3. U.S. Patent Application Publication No. 2004/0198329 A1 to Vasa**

Vasa is directed to a method of querying a network database from a mobile station to obtain contact information (Vasa, paragraph 0001). A mobile station can query a supporting wireless network for directory listing information associated with a number specified by the

query. The query can be made using SMS or other text messaging facilities and may specify a desired data format as part of the query (Vasa, Abstract). The network returns a SMS response that includes one or more data items, such as directory listing information, associated with the specified number. The information may be altered or expanded to include promotional information if the specified number is a commercial listing (Vasa, Abstract).

## **C. Legal Standards**

### **1. For Establishing Anticipation**

Section 102 of the Patent Act provides the statutory basis for an anticipation rejection and states *inter alia*:

A person shall be entitled to a patent unless

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(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. . . .

The Federal Circuit's test for anticipation has been set forth numerous times. "It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). This standard has been reinforced. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1577 (Fed. Cir. 1996) (citations omitted). Further, "a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device." *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998) (emphasis added and citations omitted).

### **2. For Establishing Obviousness**

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as being a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

*Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998) (internal citations omitted).

The burden is on the Patent Office to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.3d 1071, 1074 (Fed. Cir. 1988). “To reach a proper conclusion under § 103, the decisionmaker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made.” *Id.* at 1073 (quoting *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987) (paraphrase in *Fine*’s original text)). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine* at 1075.

The “case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight.” *Ibid.*

The Federal Circuit notes

that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved . . . The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory

statements regarding the teaching of multiple references, standing alone, are not “evidence.”

*Ibid* (internal citations omitted). It is worth noting that the *Dembiczak* court specifically acknowledged *Fine*, but emphasized the requirement for actual evidence in proving the motivation to combine the references.

It is further worth noting that where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588 (Fed. Cir. 1991); MPEP § 2143.01.

For a *prima facie* case of obviousness, the combination must teach or fairly suggest all the claim elements. *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03. If the Patent Office fails to establish obviousness, then the Appellant is entitled to a patent. *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

**D. Claims 1, 2, 4, 6, 8, 14, 16-19, 21, 23, 25, 29, 31, 33, and 34 Are Not Anticipated by Sakata**

Claim 1 reads:

A method for facilitating delivery of requested information to a user comprising:  
receiving a request for information from the user over a first network;  
sending to a telephony terminal a pointer, which identifies a location where requested information responsive to the request is located via the first network; and  
accessing the requested information in response to the request and storing the requested information at the location associated with the pointer,  
wherein the pointer is used by the telephony terminal to access the requested information via the first network.

Claim 1 thereby recites that the request for the information, the sending of the pointer, and the accessing of information associated with the pointer are all provided over a first network. In other words, in the claimed invention, the request for information, the sending of a pointer, and the use of the pointer to access the requested information all takes place over the same single network (see Figures 1 and 2, and paragraphs 00014-0018 of the Specification). Notably, Sakata fails to disclose a system where the request for the pointer, the pointer itself, and the information



associated with the pointer are all delivered over the same network. As such, claims 1, 2, 4, 6, 8, 14, 16-19, 21, 23, 25, 29, 31, 33, and 34 define patentable subject matter.

In particular, Sakata provides a mobile terminal, which will request a pointer from a billboard via a Radio Frequency Identification (RFID) interface and receive the pointer via the RFID interface (see Sakata, Figure 1, and paragraphs 0035-0036). Notably, the request sent by the mobile terminal in Sakata is a specific request for the pointer, and not a request for the information which is associated with the pointer (Sakata, paragraphs 0036-0037). In contrast, the claimed invention requests the information, and in response, is provided a pointer, which allows the information to be retrieved. Once the mobile terminal in Sakata retrieves the pointer from the billboard via the RFID interface, the pointer is used to access the information associated with the pointer through a different interface such as an Internet interface (Sakata, Figures 1, 2, 4 and 5, paragraphs 0035-0037, 0042, 0045 and 0050). In effect, different communication networks are used to obtain and ultimately use the pointer.

As such, there are two key differences between the presently claimed invention and Sakata. First, different networks are used to obtain and use the pointer in Sakata, whereas the same network is used in the claimed invention. Second, the present invention provides a request for information, not a request for the pointer. A pointer is returned, such that the location can be ultimately accessed via the same network. In Sakata, a pointer, rather than information, is requested. Since Sakata does not receive a request for information over a first network, given the strict standards for anticipation, Sakata fails to anticipate claim 1.

The Patent Office has failed to provide any basis for alleging that Sakata teaches a method where the request for the information, the sending of a pointer identifying a location where the requested information is located, and the access of information associated with the pointer are all provided over the same network. In the Final Office Action, the Patent Office notes that Sakata's apparatus operates in a wireless environment as disclosed in Figure 2, where it is disclosed that "information request power feed via radio wave." (Final Office Action mailed March 27, 2006, p. 2). However, just because this Sakata discloses a wireless environment does not mean that Sakata teaches a method where the request for the information, the sending of a pointer identifying a location where the requested information is located, and the access of information associated with the pointer are all provided over the same network. In fact, as discussed above, Sakata requests the pointer using the RFID in a wireless environment via radio

wave. The user in Sakata then uses the pointer to access the information over a different network, e.g., the Internet. In the Advisory Action, the Patent Office asserts that the request to the RFID device and the pointer back to the portable device both are over the same network (Advisory Action mailed June 23, 2006, p. 2). Even assuming this is true, Sakata then accesses information over the Internet, a second network (Sakata, Figures 1, 2, 4 and 5, paragraphs 0035-0037, 0042, 0045 and 0050). Therefore, Sakata does not teach wherein the pointer is used by the terminal to access the requested information via the first network, as required by the claimed invention. Since Sakata does not teach accessing the information over the same first network as the request for information and the sending of the pointer was performed, Sakata does not anticipate claim 1.

In the Advisory Action, the Patent Office responds to Appellant's argument that Sakata requests the pointer and not information by stating that Appellant argues that the actual information requested is transferred back to the user's phone, and that the claims do not positively recite that the actual information requested is sent back to the phone (Advisory Action mailed June 23, 2006, p. 2). First of all, the claims do positively recite that the pointer is used by the telephony terminal to access the requested information via the first network. Second, Appellant's argument is that the claims require that a request for information from the user be received over a first network. Sakata teaches a request for a pointer, not a request for information. The Patent Office does not deny this in the Advisory Action. Thus, Sakata does not teach or suggest a request for information from the user be received over a first network. Thus, Sakata fails to teach the explicit claim element.

Claim 18 contains similar limitations as claim 1, and is thus patentable for at least the same reasons as claim 1. In addition, dependent claims 2, 4, 6, 8, 14, 16, and 17 depend from claim 1 and contain all the limitations thereof. Claims 19, 21, 23, 25, 29, 31, 33, and 34 depend from claim 18 and contain all the limitations thereof. As a result, these dependent claims are also not anticipated for at least the same reasons set forth above with respect to claim 1.

Claims 2 and 19 deserve special mention. Claims 2 and 19 recite that the request for information is received via a call from the telephony terminal of the user. In particular, the Patent Office has asserted that Sakata discloses a portable terminal, which can make a call to obtain the pointer in order to access the Internet website. Simply being able to make a call does not disclose the specific claim requirement of receiving the request for information via a call. In

the Advisory Action, the Patent Office asserts that Sakata's request is a call since a call is defined as "two people or two machines on a phone line speaking to one another." First of all, as discussed above, Sakata's request is for a pointer, and is not a request for information, as claimed in the present invention. Second, even assuming this definition is proper, a point Appellant does not concede, the request for a pointer would still not be the claimed call, since the request in Sakata is via a RFID device and would not be over a phone line. Thus, Sakata does not teach or suggest that the request for information is received via a call from the telephony terminal of the user. The teachings of Ljubicich and Vasa fail to remedy these further deficiencies of Sakata. As such, claims 2 and 19 are patentable for this additional reason.

**E. Claims 1, 2, 4, 9-19, 21, and 25-34 Are Not Obvious in Light of the Combination of Ljubicich or Vasa and Sakata**

**1. Each and Every Element is Not Taught or Suggested by the Combination**

Claims 1, 2, 4, 9-19, 21, and 25-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ljubicich or Vasa in view of Sakata. Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. Also, the Patent Office is not allowed to extract isolated portions of the references; rather, the references must be considered in their entireties. MPEP § 2141.02. If the Patent Office cannot establish obviousness, the claims are allowable.

As indicated above, both claims 1 and 18 recite that the request for the information, the sending of the pointer, and the accessing of information associated with the pointer are all provided over a first network. Sakata fails to disclose obtaining and using the pointer over the same network. Sakata also fails to provide a pointer in response to a request for information, as required by the claimed invention. Instead, Sakata actually requests the pointer. The information associated with the pointer and the pointer itself cannot be construed as the same. Neither Ljubicich nor Vasa cure the deficiencies of Sakata, and as such, *prima facie* obviousness is not provided because each and every claim element cannot be found in either combination of references.

An analysis of Vasa reveals its failings. Vasa simply provides a system where a mobile terminal can request information associated with a directory number. When a request is made, the requested information is returned. A pointer to the requested information is not returned. There is no need for a pointer in Vasa, as the information is directly provided in response to the request. As such, Vasa fails to teach or suggest that the pointer is used by the telephony terminal to access the requested information over the same first network and thus fails to provide the missing elements of Sakata. Thus, claims 1 and 18 are patentable.

Ljubicich also fails to cure the deficiencies of Sakata. Ljubicich provides a system where a caller can obtain an access number for a party who has an unpublished number. The access number can be used to call the party whose number is unpublished without divulging the actual number of the party. There is no teaching or suggestion within Ljubicich that a pointer is used by the telephony terminal to access the requested information, as required by the claimed invention. Specifically, the Patent Office has identified Ljubicich's access number as the pointer of Appellant's claims (Final Office Action mailed June 23, 2006, p. 4). The Patent Office asserts that Ljubicich's access number reads on the claimed pointer because both direct, or point, the user to another location where information is located. *Id.* This assertion is unfounded. Ljubicich's access number does not point to anything. Nor does it direct the user to another location where information is located. Instead, the access number is used by the information assistance provider to connect the user to the requested party (Ljubicich, paragraph 0006). Thus, the access number is not the claimed pointer.

While the access number of Ljubicich is used to call the intended recipient, the telephony terminal user never receives the requested information (i.e., the telephone number) for the researched individual. To this extent, Ljubicich does not teach or suggest that the telephony terminal user ever receives the requested information or accesses the requested information with the access number. In no way can the access number of Ljubicich, which is effectively an alternative directory number, be construed as a pointer as claimed in the present invention. Further, making a call using the access number cannot be construed as obtaining information associated with a pointer. Ljubicich is directed to a completely different field of endeavor and is simply trying to maintain anonymity of parties wishing to have their actual directory numbers remain unpublished. Since Ljubicich does not teach or suggest using a pointer by the telephony terminal to access the requested information, independent claims 1 and 18 define patentable

subject matter. The corresponding dependent claims further limit claims 1 and 18, and are thus also patentable.

## **2. There is No Motivation to Combine the References**

In addition, there is no motivation to combine Vasa or Ljubicich with Sakata. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The fact that references can be combined is not sufficient to establish *prima facie* obviousness. MPEP § 2143.01. Likewise, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. *Id.* If the Patent Office cannot establish obviousness, the claims are allowable.

The Patent Office has provided no actual evidence to show the requisite motivation to combine Ljubicich or Vasa with Sakata to arrive at the claimed invention. Without such actual evidence, it appears as though the Patent Office is impermissibly using Appellant's disclosure in the present application as the motivation to combine. Use of Appellant's disclosure to guide the combination of references constitutes impermissible hindsight reconstruction. To cleanse the articulated motivation of the possibility of impermissible hindsight reconstruction, the Patent Office must provide evidence apart from Appellant's disclosure that supports this motivation. In this case, the Patent Office has failed to do so. In the absence of such evidence, the motivation is improper, and the rejection based on the motivation is improper.

Moreover, Ljubicich is directed to a completely different field of endeavor and is simply trying to maintain anonymity of parties wishing to have their actual directory numbers remain unpublished. Not only is Ljubicich not pertinent to any aspect of the claimed invention, the different focuses of Ljubicich and Sakata would not lead one of ordinary skill in the art to combine these references to arrive at the claimed invention.

In the Final Office Action, the Patent Office states that it would have been obvious to combine Sakata with Ljubicich or Vasa "because to substitute a pointer for an access number when one is requesting information would be within the purview of the skilled artisan with these

references in front of her” (Final Office Action mailed March 27, 2006, p. 5). This statement lacks any actual evidence in support thereof. In addition, this statement does not contain a motivation to combine the references. That is, the Patent Office has not articulated the reason why the “skilled artisan” would make such a substitution. As noted above, merely because the references can be combined is not sufficient to establish obviousness. Likewise, the fact that the invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish obviousness. Under either standard, the Patent Office’s analysis is deficient.

The Patent Office also states that Ljubicich implicitly shows a pointer being sent out from the requesting terminal in the form of an access phone number and to have substituted Sakata’s pointer that is automatically sent out instead of manually dialing in the “pointer” would have been obvious. *Id.* Once again, the Patent Office provides no actual evidence to support this statement. In addition, as discussed above, in no way can the access number of Ljubicich, which is effectively an alternative directory number, be construed as a pointer as claimed in the present invention. Further, making a call using the access number cannot be construed as obtaining information associated with a pointer. Ljubicich is directed to a completely different field of endeavor and is simply trying to maintain anonymity of parties wishing to have their actual directory numbers remain unpublished. Accordingly, the combination of Ljubicich and Sakata cannot be combined due to lack of motivation.

Likewise, the Patent Office has provided no actual evidence to show the requisite motivation to combine Vasa with Sakata to arrive at the claimed invention. The only thing the Patent Office states in this regard is that it would have been obvious to combine Sakata’s teaching of a pointer instead of the addresses of Vasa “because to substitute a pointer for an access number when one is requesting information would be within the purview of the skilled artisan with these references in front of her” (Final Office Action mailed March 27, 2006, p. 5). This is the same reason given for the combination of Sakata with Ljubicich and is not applicable to Vasa. In any event, the Patent Office provides no actual evidence to support this statement. Thus, the stated motivation is improper, thereby making the combination improper.

Since there is no actual evidence supporting a motivation to combine Sakata with Ljubicich or Vasa to arrive at the claimed invention, the motivation is improper. Since the motivation is improper, the combination is improper, and the claims are allowable.

## **F. Conclusion**

The Patent Office has not shown where all of the elements of independent claims 1 and 18 are shown with the requisite particularity to sustain an anticipation rejection. Specifically, there are two key differences between the presently claimed invention and Sakata. First, different networks are used to obtain and use the pointer in Sakata, whereas the same network is used in the claimed invention. Second, the claimed invention provides a request for information, not the pointer. A pointer is returned, such that the location can be ultimately accessed via the same network. In Sakata, a pointer is requested. Given the strict standards for anticipation, Sakata fails to anticipate independent claims 1 and 18 and the corresponding dependent claims.

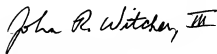
For the rejections under 35 U.S.C. § 103(a), neither Ljubicich nor Vasa cure the deficiencies of Sakata, and as such, *prima facie* obviousness is not provided because each and every claim element cannot be found in either combination of references. Ljubicich and Vasa do not cure the deficiencies of Vasa. In addition, neither Ljubicich nor Vasa teach or suggest the claimed pointer. In addition, there is no motivation to combine the references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references, which it has not done in this case. Instead, the Patent Office is improperly combining the references using hindsight to reconstruct the claimed invention using Appellant's disclosure as a template. In particular, the Patent Office has not provided any evidence to prove the motivation to combine the references, and has ignored the fact that Ljubicich is directed to an entirely different field of endeavor.

Based on the above reasons, Appellant respectfully requests that the Board find the rejections of the pending claims improper and instruct the Examiner to allow all pending claims.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

A handwritten signature in black ink, reading "John R. Witcher, III". The signature is written in a cursive style with a prominent "J" and "W".

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## **(8) APPENDIX**

1. A method for facilitating delivery of requested information to a user comprising:  
receiving a request for information from the user over a first network;  
sending to a telephony terminal a pointer, which identifies a location where requested information responsive to the request is located via the first network; and  
accessing the requested information in response to the request and storing the requested information at the location associated with the pointer,  
wherein the pointer is used by the telephony terminal to access the requested information via the first network.
2. The method of claim 1 comprising receiving a call from the user via the telephony terminal, and wherein the request is received via the call.
4. The method of claim 1 further comprising locating the requested information in response to the request and determining the pointer based on where the requested information is located.
6. The method of claim 1 further comprising creating the requested information in response to the request and storing the requested information at the location associated with the pointer.
7. The method of claim 1 wherein the requested information expires after a defined period of time and can be accessed by the telephony terminal only prior to expiration.
8. The method of claim 1 wherein the pointer is sent to the telephony terminal via a messaging service.
9. The method of claim 8 wherein the pointer is sent to the telephony terminal via a short messaging service message.
10. The method of claim 8 wherein the pointer is sent to the telephony terminal via an instant messaging message.
11. The method of claim 8 wherein the pointer is sent to the telephony terminal via an email message.

12. The method of claim 8 wherein the pointer is sent to the telephony terminal via a wireless application protocol message.
13. The method of claim 1 wherein the requested information is information available from operator services.
14. The method of claim 1 wherein the requested information is provided in at least one of the formats consisting of audio, video, graphics, text, and pictures.
15. The method of claim 1 wherein the requested information includes at least one of a group consisting of directory numbers, addresses, movie listings, driving directions, news, stock market information, order status, customer service information, sports scores, music, and video.
16. The method of claim 1 wherein the telephony terminal is a mobile terminal.
17. The method of claim 1 wherein the request is provided via voice or signal from the telephony terminal.
18. A system for facilitating delivery of requested information to a user comprising:  
at least one communication interface; and  
a control system associated with the at least one communication interface and adapted to:  
receive a request for information from the user over a first network;  
send to a telephony terminal a pointer, which identifies a location where the requested information responsive to the request is located via the first network; and  
access the requested information in response to the request and storing the requested information at the location associated with the pointer,  
wherein the pointer is used by the telephony terminal to access the requested information via the first network.
19. The system of claim 18 wherein the control system is further adapted to receive a call from the user via the telephony terminal, and wherein the request is received via the call.

21. The system of claim 18 wherein the control system is further adapted to locate the requested information in response to the request and determine the pointer based on where the requested information is located.
23. The system of claim 18 wherein the control system is further adapted to create the requested information in response to the request and store the requested information at the location associated with the pointer.
24. The system of claim 18 wherein the requested information expires after a defined period of time and can be accessed by the telephony terminal only prior to expiration.
25. The system of claim 18 wherein the pointer is sent to the telephony terminal via a messaging service.
26. The system of claim 25 wherein the pointer is sent to the telephony terminal via a short messaging service message.
27. The system of claim 25 wherein the pointer is sent to the telephony terminal via an instant messaging message.
28. The system of claim 25 wherein the pointer is sent to the telephony terminal via an email message.
29. The system of claim 25 wherein the pointer is sent to the telephony terminal via a wireless application protocol message.
30. The system of claim 18 wherein the requested information is information available from operator services.
31. The system of claim 18 wherein the requested information is provided in at least one of the formats consisting of audio, video, graphics, text, and pictures.

32. The system of claim 18 wherein the requested information includes at least one of a group consisting of directory numbers, addresses, movie listings, driving directions, news, stock market information, order status, customer service information, sports scores, music, and video.
33. The system of claim 18 wherein the telephony terminal is a mobile terminal.
34. The system of claim 18 wherein the request is provided via user voice or signal from the telephony terminal.

**(9) EVIDENCE APPENDIX**

Appellant relies on no evidence, thus this appendix is not applicable.

**(10) RELATED PROCEEDINGS APPENDIX**

As there are no related proceedings, this appendix is not applicable.